

REMARKS

Claims 1-13 and 15-18 remain in the application with claims 1 amended to correct a misspelled word and address an objection noted by the Examiner.

Reconsideration is respectfully requested for claims 1-13 and 15-18 as amended.

The Examiner has objected to claim 1 because of the misspelling of the word "from". By the present amendment, the spelling is corrected.

The Examiner has objected to claim 3, the Examiner questioning how the claim further limits the invention.

Claim 1 specifies a probe for detecting magnetic resonance signals emitted from a region of interest including a conducting medium in an object. Claims 3 and 4 further describe the conducting medium set forth in the preamble as comprising tissue or fluid. The "tissue" or "fluid" are not part of the claimed probe but do define the environment specified in the preamble in which the probe can operate.

Claims 1-11, 13 and 16-18 have been rejected under 35 USC § 102(e) as being anticipated by Susil et al. (US 2003/0050557 A1) the Examiner referring to Figs. 2H, 2I and the description in paragraphs 62, 84 89, and 90.

This rejection is respectfully traversed since the subject matter in the Susil drawings and specification are limited to the filing date of April 15, 2002. The Susil publication claims priority as a continuation in part of application number 09/428,990 filed October 29, 1999 which is based on provisional application 60/106,965, filed on November 4, 1998. Enclosed is a copy of provisional application no. 60/ 106,995 which does not disclose the material in the continuation in part application filed April 15, 2002 relied on by the Examiner. The file history for application number 09/428,990 has not been available in the US Patent and Trademark Office.

It is noted that priority is also claimed from provisional application number 60/283,725 which was filed on April 13, 2001. However, the Susil et al. continuation in part application filed April 15, 2002 was not filed within one year of the filing data of provisional application number 60/283,725 and thus cannot claim priority therefrom. See 35 USC § 119(e)(1).

Regarding provisional application number 60/106,965 filed on November 4, 1998, from which the continuation in part application does have a valid claim of priority, the relevant portions appear on pages 10, 11, and 12 with regard to the catheter design, and figures 13, 14 illustrating the catheter design. As there described, the active element of the antenna may run

within the ablation catheter in a coaxial fashion, or the RF ablation element itself may be designed to serve both as an RF ablation transmitter and a receiver coil for MR imaging. A switching device can be used to switch the catheter between imaging and ablation modes. Thus, the ablation electrode functions for both ablation and imaging and does not comprise first and second electrodes as claimed.

While Fig. 13 does illustrate diagnostic electrodes on the surface of the catheter, the description in the caption under fig. 14 states that the diagnostic electrodes are for recording intracardiac potentials.

Accordingly, it is respectfully submitted that the material in the Susil publication relied upon by the Examiner is restricted to the filing data of April 15, 2002, which is after the filing data of the present application of July 12, 2001.

Claims 12 and 15 have been rejected under 35 USC § 103(a) as being unpatentable over Susil et al., the Examiner noting that Susil fails to teach needle electrodes. The Examiner contends that the MR detecting coils can take on a plurality of shapes, including needle electrodes.

This rejection is respectfully traversed for the reasons given above regarding the filing date of the Susil et al. publication. Since the Susil et al. publication is not entitled to the filing date of provisional application 60/106,965 it is believed that the application disclosure relied upon by the Examiner is not prior art.

However, assuming arguendo that Susil et al. were prior art, needle electrodes would not be compatible therewith. Susil et al. disclose only electrodes in the form of coils positioned on the surface of a catheter and nowhere does Susil show or suggest the modification of this catheter to accommodate needle electrodes. Accordingly, it is respectfully submitted that claims 12 and 15 are not obvious from the disclosure of the Susil et al. publication.

Since the objections to claims 1 and 3 noted by the Examiner have been addressed, since claims 1-13 and 15-18 are patentable under 35 USC § 102(e) and 103 over Susil et al., all as above set forth, it is requested that claims 1-13 and 15-18 as amended be allowed and the case advanced to issue.

Applicant believes that all pending claims are allowable and respectfully requests a Notice of Allowance for this application from the Examiner. Should the Examiner have any question or comment concerning the present amendment and response, a telephone call to the undersigned attorney is requested.

Applicants hereby petition for an extension of time which may be required to maintain the pendency of this case, and any required fee for such extension or any further fee required in connection with the filing of this Amendment is to be charged to Deposit Account No. 500388 (Order No. STFUP076).

Respectfully submitted,
BEYER WEAVER & THOMAS, LLP

A handwritten signature in black ink, reading "Henry K. Woodward". The signature is fluid and cursive, with the first name "Henry" and last name "Woodward" clearly legible.

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